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UNITED STATES DISTRICT COURT

DISTRICT OF NEVADA

UPMANN SANCHEZ TURF AND
 LANDSCAPE, INC., dba US Turf,

Plaintiff,

v.

US TURF, LLC, dba Serenity
 Landscaping,

Defendant.

US TURF, LLC,

Counterclaimant,

v.

UPMANN SANCHEZ TURF AND
 LANDSCAPE, INC.

Counter-Defendant.

Case No. 2:21-cv-01749-JCM-DJA

**DEFENDANT’S ANSWER AND
 COUNTERCLAIMS**

JURY DEMAND

US TURF, LLC (“Defendant” or “Counterclaimant”), by and through its undersigned counsel of record, hereby answers the allegations in the Complaint filed by UPMANN SANCHEZ TURF AND LANDSCAPE, INC. (“Plaintiff” or “Counter-Defendant”), and asserts affirmative defenses and counterclaims as provided herein. Defendant denies all allegations contained in the Complaint that are not specifically admitted. Defendant denies that Plaintiff is entitled to any relief, including the relief that Plaintiff requests. The paragraph numbers in the Answer below correspond to those in Plaintiff’s Complaint.

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JURISDICTION AND VENUE

1
2 1. Defendant maintains that this paragraph contains declaratory statements and/or
3 asserts conclusions of law to which no response is required. To the extent a response is deemed
4 necessary, Defendant denies the allegations contained this paragraph of the Complaint.

5 2. Defendant maintains that this paragraph contains declaratory statements and/or
6 asserts conclusions of law to which no response is required. To the extent a response is deemed
7 necessary, Defendant denies the allegations contained in this paragraph of the Complaint.

8 3. Defendant admits it is a Nevada limited liability company created to and doing
9 business in Nevada since May 14, 2020, and on such basis, admits that this Court has personal
10 jurisdiction over Defendant. To the extent that any further response is deemed necessary,
11 Defendant denies the remaining allegations set forth this paragraph of the Complaint.

12 4. Defendant admits the allegations set forth in this paragraph of the Complaint.

13 **PARTIES**

14 5. Defendant is without knowledge or information sufficient to form a belief as to the
15 truth of the allegations contained this paragraph of the Complaint and, therefore, denies the same.

16 6. Defendant admits the allegations set forth in this paragraph of the Complaint.

17 7. Defendant admits it is a Nevada limited liability company created to and doing
18 business in Nevada since May 14, 2020, and on such basis, admits that this Court has personal
19 jurisdiction over Defendant. To the extent that any further response is deemed necessary,
20 Defendant denies the remaining allegations set forth this paragraph of the Complaint.

21 **ALLEGATIONS FOR ALL CLAIMS FOR RELIEF**

22 **Plaintiff's "US Turf" Business and Trademarks**

23 8. Defendant is without knowledge or information sufficient to form a belief as to
24 the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the
25 same.

26 9. Defendant is without knowledge or information sufficient to form a belief as to
27 the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the
28 same.

1 10. Defendant is without knowledge or information sufficient to form a belief as to
2 the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the
3 same.

4 11. Defendant is without knowledge or information sufficient to form a belief as to
5 the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the
6 same.

7 12. Defendant is without knowledge or information sufficient to form a belief as to
8 the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the
9 same.

10 13. Defendant is without knowledge or information sufficient to form a belief as to
11 the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the
12 same.

13 14. Defendant is without knowledge or information sufficient to form a belief as to
14 the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the
15 same.

16 15. Defendant is without knowledge or information sufficient to form a belief as to
17 the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the
18 same.

19 16. Defendant is without knowledge or information sufficient to form a belief as to
20 the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the
21 same.

22 **Defendant's Infringement And Unlawful Use Of Plaintiff's Trademarks**

23 17. Defendant admits the allegations set forth in this paragraph of the Complaint.

24 18. Defendant is without knowledge or information sufficient to form a belief as to
25 the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the
26 same.

27 19. Defendant admits the allegations set forth in this paragraph of the Complaint.

28 20. Defendant admits the allegations set forth in this paragraph of the Complaint.

21. Defendant admits that it operates a Facebook page and other social media websites for the marketing and promotion of its business but denies the remaining allegations set forth in this paragraph of the Complaint.

22. Defendant admits receiving the letter referenced in this paragraph and not responding to said letter but denies the remaining allegations set forth in this paragraph of the Complaint.

23. Defendant denies the allegations set forth in this paragraph of the Complaint.

24. Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the same.

25. Defendant denies the allegations set forth in this paragraph of the Complaint.

26. Defendant denies the allegations set forth in this paragraph of the Complaint.

27. Defendant denies the allegations set forth in this paragraph of the Complaint.

28. Defendant denies the allegations set forth in this paragraph of the Complaint.

29. Defendant denies the allegations set forth in this paragraph of the Complaint.

30. Defendant denies the allegations set forth in this paragraph of the Complaint.

31. Defendant denies the allegations set forth in this paragraph of the Complaint.

32. Defendant denies the allegations set forth in this paragraph of the Complaint.

FIRST CLAIM FOR RELIEF

(Trademark Infringement: 15 U.S.C. §1114)

33. Defendant repeats, realleges and incorporates by reference Defendant's answers to the allegations in the preceding and ensuing paragraphs of Plaintiff's Complaint as if fully set forth herein.

34. Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the same.

35. Defendant maintains that this paragraph contains declaratory statements and/or asserts conclusions of law to which no response is required. To the extent a response is deemed

1 necessary, Defendant denies the allegations contained this paragraph of the Complaint.

2 36. Defendant denies the allegations set forth in this paragraph of the Complaint.

3 37. Defendant denies the allegations set forth in this paragraph of the Complaint.

4 38. Defendant denies the allegations set forth in this paragraph of the Complaint.

5 39. Defendant denies the allegations set forth in this paragraph of the Complaint.

6 40. Defendant maintains that this paragraph contains declaratory statements and/or
7 asserts conclusions of law to which no response is required. To the extent a response is deemed
8 necessary, Defendant denies the allegations contained this paragraph of the Complaint.

9 **SECOND CLAIM FOR RELIEF**

10 **(Unfair Competition under Lanham Act: 15 U.S.C. § 1125(a))**

11 41. Defendant repeats, realleges and incorporates by reference Defendant's answers to
12 the allegations in the preceding and ensuing paragraphs of Plaintiff's Complaint as if fully set forth
13 herein.

14 42. Defendant is without knowledge or information sufficient to form a belief as to the
15 truth of the allegations contained in this paragraph of the Complaint and, therefore, denies the
16 same.

17 43. Defendant denies the allegations set forth in this paragraph of the Complaint.

18 44. Defendant denies the allegations set forth in this paragraph of the Complaint.

19 45. Defendant denies the allegations set forth in this paragraph of the Complaint.

20 **THIRD CLAIM FOR RELIEF**

21 **(Injunctive Relief Under Lanham Act: 15 U.S.C. § 1116)**

22 46. Defendant repeats, realleges and incorporates by reference Defendant's answers to
23 the allegations in the preceding and ensuing paragraphs of Plaintiff's Complaint as if fully set forth
24 herein.

25 47. Defendant denies the allegations set forth in this paragraph of the Complaint.

26 48. Defendant denies the allegations set forth in this paragraph of the Complaint.

27 49. Defendant denies the allegations set forth in this paragraph of the Complaint.

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The allegations set forth in the paragraphs requesting relief are in the nature of a prayer. Although no response is required, Defendant denies the allegations in Plaintiff's prayer for relief and denies that Plaintiff is entitled to an award of any relief whatsoever from Defendant or this Court.

Having fully answered the Complaint and without admitting any facts not above admitted to, Defendant asserts the following affirmative defenses:

2. Defendant asserts that some or all of the marks at issue fail to function as trademarks, and thus bar Plaintiff's claims.

4. Defendant asserts that some or all of the marks at issue are geographically descriptive and have not acquired distinctiveness or secondary meaning.

5. Defendant asserts that some or all of the marks at issue lack inherent distinctiveness or secondary meaning.

6. Defendant asserts that it did not “use” Plaintiff’s marks as contemplated by the Lanham Act.

7. Defendant asserts that some or all of the marks at issue are barred or limited from recovery in whole or in part by the doctrines of fair use, nominative fair use, and/or descriptive use.

8. Plaintiff has expressly acknowledged the descriptive/generic nature of the term “US TURF” by virtue of Plaintiff’s disclaimer of any exclusive rights to use of the term “US TURF” in its federal trademark registration for the USTURF design mark (US Trademark Registration No. 5,982,235).

///

1 9. Defendant asserts that Plaintiff's claims asserting violation of its rights are barred
2 or limited from recovery in whole or in part by the equitable doctrines of estoppel, laches, waiver,
3 and/or acquiescence. Despite Plaintiff having actual notice of Defendant's use of the business
4 name US TURF on or about October 2020 (as evidenced by Plaintiff's own cease and desist letter
5 to Defendant dated October 21, 2020), Plaintiff took no legal action to prevent Defendant's
6 continued use of the business name US TURF until the filing of this lawsuit nearly a year later and
7 only after Plaintiff had fraudulently procured a federal registration for the US TURF standard
8 character word mark. Since May 2020, and at least in partial reliance upon Plaintiff's delay and
9 acquiescence, Defendant did and has continued to build its business and goodwill within the Las
10 Vegas metropolitan market under the business name US TURF.

11 10. Defendant asserts that there is no likelihood of confusion between Plaintiff's
12 asserted marks and Defendant's marks.

13 11. Defendant asserts that there is no likelihood of confusion between Plaintiff's
14 asserted marks and Defendant's marks because of the descriptive/generic nature of the marks at
15 issue.

16 12. Defendant asserts that there is no likelihood of confusion between Plaintiff's
17 asserted marks and Defendant's marks because the parties' respective marks are used in separate
18 geographic areas.

19 13. Plaintiff is not entitled to any injunctive relief under the *Dawn Donut* rule given the
20 distinct geographic markets in which the parties operate.

21 14. Defendant asserts that Plaintiff's claims are barred or limited from recovery in
22 whole or in part because any infringement was innocent, inadvertent, and or made without
23 knowledge of any rights Plaintiff may have.

24 15. Defendant was using the mark US TURF in the Las Vegas metropolitan area prior
25 to any actual use in commerce of said mark by Plaintiff in such geographic area and prior to any
26 applicable constructive nationwide use, and therefore Defendant has priority of use of the mark
27 US TURF in the Las Vegas metropolitan area based upon its pre-existing common law rights to
28 the mark US TURF.

1 16. Defendant's use of the mark US TURF was innocently adopted and used in the Las
2 Vegas metropolitan area before any actual or constructive notice of Plaintiff's alleged trademark
3 rights.

4 17. Defendant's use of the mark US TURF within the Las Vegas metropolitan area is
5 not actionable by Plaintiff under the *Tea-Rose/Rectanus* doctrine.

6 18. Defendant asserts that Plaintiff may not rely on its federal trademark registration
7 for the US TURF word mark (US Trademark Registration No. 6,439,091) because Plaintiff
8 obtained such trademark registration using false and fraudulent misrepresentations.

9 19. Defendant asserts that Plaintiff's claims are barred or limited from recovery in
10 whole or in part by the doctrine of unclean hands. Specifically, Plaintiff obtained its federal
11 trademark registration for the US TURF word mark (US Trademark Registration No. 6,439,091)
12 by committing fraud on the US Patent and Trademark Office ("US PTO"). Furthermore, Plaintiff
13 is misusing the mark US TURF to deceive the public into believing that US references the United
14 States and that Plaintiff's company offers services throughout the US, when, by Plaintiff's own
15 admission, Plaintiff's use of US as used in the trademark refers to UPMANN SANCHEZ and
16 Plaintiff has only ever provided turf installation services in the San Diego area.

17 20. Defendant asserts that Plaintiff's claims are barred or limited from recovery in
18 whole or in part because any infringement was *de minimus* and of no detrimental effect to Plaintiff.

19 21. Defendant asserts that Plaintiff has sustained no harm, irreparable or otherwise, due
20 to Defendant's actions.

21 22. Defendant asserts that Plaintiff's claims are barred or limited from recovery in
22 whole or in part because Plaintiff's damages, if any, were not caused by Defendant.

23 23. Defendant asserts that there has been no damage in any amount, manner, or at all
24 by reason of any act alleged against Defendant in the Complaint and the relief prayed for in the
25 Complaint cannot be granted.

26 24. Defendant asserts that Plaintiff's claims for injunctive relief are barred because
27 Plaintiff cannot show that it will suffer any irreparable harm from Defendant's actions.

28 25. Defendant asserts, without admitting that the Complaint states a claim, that any

1 remedies are limited to the extent there is an overlapping or duplicative recovery for any alleged
2 single wrong.

3 26. Defendant asserts that the claims made in the Complaint are barred or limited from
4 recovery in whole or in part due to other parties' use of any of the marks at issue.

5 27. Defendant hereby incorporates by reference those affirmative defenses enumerated
6 in Rule 8 of the Federal Rules of Civil Procedure as if fully set forth herein. In the event further
7 investigation or discovery reveals the applicability of any such defenses, Defendant reserves the
8 right to seek leave of court to amend its Answer to Plaintiff's Complaint to specifically assert any
9 such defenses.

10 28. Pursuant to Rule 11 of the Federal Rules of Civil Procedure, all possible affirmative
11 defenses may not have been alleged herein insofar as sufficient facts were not available after
12 reasonable inquiry upon filing of this answer in the Plaintiff's Complaint and Defendant reserves
13 the right to amend its Answer to Plaintiff's Complaint as additional information becomes available
14 or as additional affirmative defenses are revealed in the course of discovery.

15
16 **PRAYER FOR RELIEF**

17 WHEREFORE, having answered Plaintiff's Complaint, Defendant prays for judgment as
18 follows:

- 19 1. That the Plaintiff take nothing by reason of its Complaint.
20 2. That Plaintiff's claims be dismissed against Defendant with prejudice.
21 3. Finding that this is an exceptional case and awarding all attorney's fees incurred by
22 Defendant under 15 U.S.C. § 1117.
23 4. For costs and disbursements incurred by Defendant in connection with this lawsuit.
24 5. For such other further relief as the Court may deem just and proper.

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COUNTERCLAIMS

Counterclaimant US TURF LLC (hereinafter “Counterclaimant”), by and through its attorney of record, hereby alleges against Counterclaim Defendant UPMANN SANCHEZ TURF AND LANDSCAPE, INC. (hereinafter “Counter-Defendant”) as follows:

JURISDICTION

1. This Court has subject matter jurisdiction over the following counterclaims pursuant to 28 U.S.C. §§ 1331 and 1338 with respect to the claims arising under the Lanham Act, 15 U.S.C. § 1051, *et seq.*, and pursuant to the Declaratory Judgment Act, 28 U.S.C. § 2201, *et seq.*

2. This Court has personal jurisdiction over Counter-Defendant because Counter-Defendant has submitted to jurisdiction of the Court by filing the Complaint.

3. Venue is proper in this Judicial District under 28 U.S.C. §§ 1391 and/or 1400 at least because Counter-Defendant filed the Complaint in this District.

PARTIES

4. Counterclaimant is, and at all times relevant hereto was, a Nevada limited liability company with its principal place of business located at 4050 W. Harmon Avenue, Ste 1, Las Vegas, NV 89103, authorized to and conducting business in Clark County, Nevada.

5. Counter-Defendant alleges it is, and at all times relevant hereto was, a California corporation with its principal place of business located at 8888 Miramar Rd. Suite 100, San Diego CA, 92126.

ALLEGATIONS COMMON TO ALL COUNTERCLAIMS

Prosecution History of Plaintiff’s Alleged Trademarks

6. On July 22, 2019, Counter-Defendant filed a US trademark registration application for the following design mark in connection with “laying of artificial turf” on the basis of alleged actual use at least as early as July 2018 (US Trademark Application Serial No. 88527782):



1 7. On October 11, 2019, the United States Patent and Trademark Office (“US PTO”)
2 entered a disclaimer on the record which expressly disclaimed any exclusive rights to use of the
3 wording “US TURF” by Counter-Defendant apart from the entire design mark as shown.

4 8. The registration for this mark was issued on February 11, 2020 (US Trademark
5 Registration No. 5,982,235) and included the following express disclaimer of the generic wording
6 “US TURF”– “No claim is made to the exclusive right to use “US TURF” apart from the mark as
7 shown.”

8 9. On or about October 21, 2020, Counter-Defendant sent a cease and desist letter to
9 Counterclaimant after Counter-Defendant became aware of Counterclaimant using the business
10 name US TURF for turf installation services in the Las Vegas metropolitan geographic area.

11 10. After Counter-Defendant was well aware of Counterclaimant’s use-in-commerce
12 of the name US TURF in the Las Vegas metropolitan geographic area for turf installation services,
13 Counter-Defendant, on November 3, 2020, filed another US trademark registration application
14 with the US PTO for the standard character word mark US TURF in connection with “laying of
15 artificial turf.”

16 11. The November 3, 2020, trademark registration application was signed by “Stephen
17 C. Beuerle,” identified as “Attorney of record” for Counter-Defendant, and who is an attorney with
18 the same law firm that sent the October 21, 2020, cease and desist letter on behalf of Counter-
19 Defendant.

20 12. On April 7, 2021, the US PTO issued an Office Action which refused registration
21 of the US TURF word mark on the basis that it is primarily geographically descriptive of the origin
22 of Counter-Defendant’s services.

23 13. Sometime thereafter, Counter-Defendant (through its counsel of record) contacted
24 the US PTO and represented to the Examining Attorney, *inter alia*, that “US stands for UPMANN
25 SANCHEZ” and, based on such representation, the US PTO approved the mark for publication
26 without any disclaimer of the generic wording US TURF, but rather only requiring a disclaimer
27 for the word TURF.

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14. The US TURF standard character word mark was subsequently registered on August 3, 2021, as US Trademark Registration No. 6,439,091.

15. Despite Counter-Defendant's prior express acknowledgment of the descriptive/generic nature of the wording "US TURF" and express disclaimer of any exclusive rights to use of "US TURF" apart from its design mark as shown and its express representations to the US PTO that "US stands for UPMANN SANCHEZ" upon which the US PTO relied in approving the application for US TURF, Counter-Defendant is now claiming exclusive rights to the abbreviation US in order to stop third parties from using US in its common geographically descriptive manner, namely the ubiquitous abbreviation for the United States.

Counter-Defendant's Alleged Mark Is Descriptive and Lacks Secondary Meaning

16. US is a well-known, widely-recognized abbreviation for the United States, otherwise known as the United States of America, a country with a population of over 300 million people.

17. The primary significance to the general public of the term US is that of a well-known location, namely the United States of America or United States.

18. Counter-Defendant's artificial turf installation services originate in the US as evidenced by Counter-Defendant's own allegations that "Plaintiff services clients who are located all over the United States" (Complaint, ¶8).

19. The term US is geographically descriptive of the services offered by Counter-Defendant.

20. The word TURF is generic of Counter-Defendant's services of laying artificial "turf," and adding the generic wording TURF to a geographically descriptive word like US does not diminish that geographic word's primary geographic significance.

21. The generic wording TURF is modified by US and places Counter-Defendant's turf laying services in a geographic context since Counter-Defendant is located in and provides services in the US.

22. Consumers encountering Counter-Defendant's US TURF mark would perceive the terms US TURF in the mark as merely describing a feature of the Counter-Defendant's services,

1 namely turf laying services, along with the geographic origin of such services, namely within the
2 US, and would not perceive the US TURF mark as a uniquely distinctive source-identifier.

3 23. Counter-Defendant's descriptive US TURF mark has not acquired any secondary
4 meaning of identifying Counter-Defendant's turf installation services exclusively.

5 24. Accordingly, the mark US TURF is geographically descriptive, and thus cannot be
6 registered as a trademark on the Principal Register under Section 2(e)(2) of the Lanham Act (15
7 U.S.C. §§ 1052(e)), nor can Counter-Defendant claim any enforceable trademark rights to the
8 descriptive term as against Counterclaimant's use of the name US TURF within the Las Vegas
9 geographic area.

10 **Counterclaimant's Usage of the Business Name US TURF**

11 25. Counterclaimant was formed as a Nevada limited liability company on May 14,
12 2020, after its two principal owners decided to join forces to create the #1 artificial turf installation
13 company in the Las Vegas metropolitan area.

14 26. The business name US TURF was selected because the word TURF immediately
15 informs customers of Counterclaimant's primary business, namely involving artificial turf, and US
16 immediately informs customers of the company's geographic presence within the United States.

17 27. At the time of Counterclaimant's formation, there were no other companies
18 providing turf installation services within the Las Vegas metropolitan area under the business name
19 US TURF or otherwise using US TURF as a trademark or service mark.

20 28. On or about June 17, 2020, Counterclaimant registered the domain name
21 www.usturflv.com to use in connection with promoting its US TURF business within Las Vegas.

22 29. Soon thereafter, Counterclaimant published a website which began marketing and
23 promoting its turf installation services in the Las Vegas metropolitan area under the US TURF
24 name and service mark.

25 30. On or about June 29, 2020, Counterclaimant began providing artificial turf
26 installation services to clients in the Las Vegas metropolitan area and has continuously provided
27 such services to clients in such geographic area to the present.

28 ///

31. In or around September 2020, in order to expand its marketing and promotion of its business, Counterclaimant began creating accounts for its US TURF business on various social media platforms, including a US TURF Facebook account (<https://www.facebook.com/usturf/>) and USTURF Instagram profile (<https://www.instagram.com/us.turf>) – neither of which had been previously registered by any third party.

32. At around the same time, Counterclaimant also claimed the local Las Vegas Yelp profile page for US TURF (<https://www.yelp.com/biz/us-turf-las-vegas>) and Yelp does not show any other turf installation businesses within the Las Vegas metropolitan area using the name US TURF.

33. Based on Counterclaimant's successful marketing efforts of its US TURF business in Las Vegas, the US TURF name has acquired a secondary meaning within the Las Vegas metropolitan area as identifying Counterclaimant's turf installation services exclusively.

34. Upon information and belief, Counter-Defendant has never provided any services relating to the installation of artificial turf to any customers within the Las Vegas metropolitan area prior to Counterclaimant first providing such services under the US TURF business name.

35. Upon information and belief, Counter-Defendant provides its services solely to customers within the geographic area of San Diego, California, and has always used the domain name www.usturfsandiego.com as the domain name for its website promoting its San Diego turf installation services.

FIRST COUNTERCLAIM

(Declaratory Relief of Non-Infringement – Innocent Local Use)

36. Counterclaimant repeats, realleges and incorporates herein each of the foregoing allegations in the preceding paragraphs of these Counterclaims as if fully set forth herein.

37. This is a counterclaim for declaratory judgment pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201, 2202.

38. Based on the allegations above, there is an actual and substantial controversy between Counterclaimant and Counter-Defendant, who have adverse legal interests. Counter-Defendant has made clear to Counterclaimant its belief that its alleged trademark is currently being

1 infringed by Counterclaimant's use of the business name US TURF and Counterclaimant denies
2 any wrongdoing. The dispute between Counterclaimant and Counter-Defendant is substantial,
3 definite, concrete and immediate, and not hypothetical.

4 39. Counter-Defendant's assertions that Counterclaimant is violating its legal rights
5 irreparably injures Counterclaimant and adversely affects its ongoing business and the large
6 investment it has made in its US TURF business name and attendant goodwill within the Las Vegas
7 metropolitan area. These assertions will continue to adversely affect Counterclaimant's business
8 until they are determined by this Court to lack merit.

9 40. Counterclaimant adopted the US TURF name for its business without actual or
10 constructive knowledge of Counter-Defendant's trademark claims of exclusivity to the standard
11 character word mark US TURF in connection with turf installation services.

12 41. Counterclaimant has continuously used the US TURF name in the Las Vegas
13 metropolitan area in connection with its turf installation services since at least as early as June
14 2020.

15 42. Counterclaimant's adoption of the US TURF name was before Counter-Defendant
16 filed its trademark registration application for the standard character word mark US TURF with
17 the US PTO.

18 43. As such, Counterclaimant does not infringe upon Counter-Defendant's trademark
19 rights pursuant to 15 U.S.C. §1115(b)(5).

20 44. Counterclaimant denies that its use of the US TURF mark violates Counter-
21 Defendant's trademark rights since the use by Counterclaimant of the US TURF name is not in
22 violation of any rights Counter-Defendant might have pursuant to 15 U.S.C. §§ 1114(1) or 1125(a).

23 45. Accordingly, Counterclaimant requests that this Court resolve the competing
24 contentions of the parties and declare that Counterclaimant's prior innocent local use of the US
25 TURF name in the Las Vegas metropolitan area does not infringe Counter-Defendant's trademark
26 rights and that Counterclaimant's future use of the US TURF name within the Las Vegas
27 metropolitan area does not infringe upon Counter-Defendant's trademark rights to US TURF.

28 46. Additionally or in the alternative, Counterclaimant requests that this Court resolve

1 the competing contentions of the parties and declare that Counterclaimant was using the mark US
 2 TURF in the Las Vegas metropolitan area prior to any actual use in commerce of said mark by
 3 Counter-Defendant in such geographic area and prior to any applicable constructive nationwide
 4 use, and therefore Counterclaimant has priority of use of the mark US TURF in the Las Vegas
 5 metropolitan area based on its pre-existing common law rights to the mark US TURF.

6 47. In order to resolve the legal and factual questions raised by Counter-Defendant and
 7 to afford relief from the uncertainty and controversy that Counter-Defendant's assertions have
 8 precipitated, Counterclaimant is entitled to a declaratory judgment of its rights under 28 U.S.C.
 9 §§ 2201–02.

10 **SECOND COUNTERCLAIM**

11 **(Cancellation/Modification of the US TURF Trademark Registration – Priority of Use)**

12 48. Counterclaimant repeats, realleges and incorporates herein each of the foregoing
 13 allegations in the preceding paragraphs of these Counterclaims as if fully set forth herein.

14 49. This is a counterclaim for cancellation pursuant to 15 U.S.C. §§ 1052(d) and
 15 1064(3).

16 50. Under 15 U.S.C. §1119, the Court has jurisdiction “[i]n any action involving a
 17 registered mark . . . to order the cancelation of registrations. . . , and otherwise rectify the register
 18 with respect to the registrations of any party to the action.”

19 51. Because Counter-Defendant's US trademark registration for the US TURF word
 20 mark consists of a mark which was previously used and not abandoned by Counterclaimant prior
 21 to the date of Counter-Defendant's application to register the US TURF word mark, such
 22 registration is contrary to the provisions of 15 U.S.C. §1052(d) and subject to cancellation under
 23 15 U.S.C. §1064(3), and therefore, this Court, under 15 U.S.C. §1119, should order that US
 24 Trademark Registration No. 6,439,091 be canceled in order to rectify the register.

25 52. In the alternative, should the Court not otherwise order US Trademark Registration
 26 No. 6,439,091 to be canceled or otherwise deem the word mark unenforceable, then, based on
 27 Counterclaimant's existing use-in-commerce of the US TURF mark prior to the filing date of
 28 Counter-Defendant's application for the US TURF word mark, the Court should find that

Counterclaimant is entitled to continue to use the US TURF mark in connection with artificial turf installation services within the Las Vegas metropolitan area and, consistent with 15 U.S.C. §1052(d) and as authorized under 15 U.S.C. §1119, order the Director of the US PTO to modify US Trademark Registration No. 6,439,091 to be a concurrent registration covering the entire United States except the Las Vegas metropolitan area.

THIRD COUNTERCLAIM

(Declaratory Relief of Non-Infringement – Merely Descriptive)

53. Counterclaimant repeats, realleges and incorporates herein each of the foregoing allegations in the preceding paragraphs of these Counterclaims as if fully set forth herein.

54. This is a counterclaim for declaratory judgment pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201, 2202.

55. Based on the allegations above, there is an actual and substantial controversy between Counterclaimant and Counter-Defendant, who have adverse legal interests. Counter-Defendant has made clear to Counterclaimant its belief that its alleged trademark is currently being infringed by Counterclaimant's use of the business name US TURF and Counterclaimant denies any wrongdoing. The dispute between Counterclaimant and Counter-Defendant is substantial, definite, concrete and immediate, and not hypothetical.

56. Counter-Defendant's assertions that Counterclaimant is violating its legal rights irreparably injures Counterclaimant and adversely affects its ongoing business and the large investment it has made in its US TURF business name and attendant goodwill within the Las Vegas metropolitan area. These assertions will continue to adversely affect Counterclaimant's business until they are determined by this Court to lack merit.

57. Counterclaimant's services originate from within the US and involve the installation of artificial turf. Accordingly, Counterclaimant's use of US TURF is primarily geographically descriptive of the origin of Counter-Defendant's services, namely the offering of turf installation services within the US. As such, Counterclaimant does not infringe upon Counter-Defendant's trademark rights pursuant to 15 U.S.C. §1115(b)(4).

58. Counterclaimant further denies that its use of the US TURF mark violates Counter-

1 Defendant's alleged trademark rights since the use by Counterclaimant of the US TURF name is
 2 not in violation of any rights Counter-Defendant might have pursuant to 15 U.S.C. §§ 1114(1) or
 3 1125(a).

4 59. Accordingly, Counterclaimant requests that this Court resolve the competing
 5 contentions of the parties and declare that Counterclaimant's use of the US TURF name in the Las
 6 Vegas metropolitan area does not infringe Counter-Defendant's alleged trademark rights and that
 7 Counterclaimant's future use of the US TURF name within the Las Vegas metropolitan area does
 8 not infringe upon Counter-Defendant's alleged trademark rights to US TURF.

9 60. In order to resolve the legal and factual questions raised by Counter-Defendant and
 10 to afford relief from the uncertainty and controversy that Counter-Defendant's assertions have
 11 precipitated, Counterclaimant is entitled to a declaratory judgment of its rights under 28 U.S.C.
 12 §§ 2201–02.

13 **FOURTH COUNTERCLAIM**

14 **(Cancellation/Modification of the US TURF Trademark Registration – Merely Descriptive)**

15 61. Counterclaimant repeats, realleges and incorporates herein each of the foregoing
 16 allegations in the preceding paragraphs of these Counterclaims as if fully set forth herein.

17 62. This is a counterclaim for cancellation pursuant to 15 U.S.C. §§ 1052(e) and
 18 1064(3).

19 63. Because US TURF is merely descriptive when used in connection with “laying of
 20 artificial turf,” such registration is contrary to the provisions of 15 U.S.C. §1052(e) and subject to
 21 cancellation under 15 U.S.C. §1064(3), and therefore, this Court, under 15 U.S.C. §1119, should
 22 order that US Trademark Registration No. 6,439,091 be canceled in order to rectify the register.

23 64. In the alternative, should the Court not otherwise order US Trademark Registration
 24 No. 6,439,091 to be canceled or otherwise deem the word mark unenforceable, then, based on the
 25 merely descriptive nature of the standard character word mark US TURF, the Court should rectify
 26 the register with respect to Counter-Defendant's registration thereof and order that US Trademark
 27 Registration No. 6,439,091 be amended to be on the Supplemental Register of the US PTO.

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FIFTH COUNTERCLAIM

(Damages For Federal Trademark Registration Obtained by Fraud)

65. Counterclaimant repeats, realleges and incorporates herein each of the foregoing allegations in the preceding paragraphs of these Counterclaims as if fully set forth herein.

66. This is a counterclaim for damages pursuant to 15 U.S.C. §§ 1120 and 1064(3)).

67. Under 15 U.S.C. § 1120:

Any person who shall procure registration in the Patent and Trademark Office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof.

68. Counter-Defendant obtained US Trademark Registration No. 6,439,091 for the standard character word mark US TURF, which issued on August 3, 2021, on the US PTO's Principal Register.

69. All applicants for trademark registration with the US PTO based on use-in-commerce must sign the following standard declaration statements as part of the application (emphasis added):

- ☐ The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.
- ☐ The signatory believes that the applicant is the owner of the trademark/service mark sought to be registered; The mark is in use in commerce and was in use in commerce as of the filing date of the application on or in connection with the goods/services in the application; The specimen(s) shows the mark as used on or in connection with the goods/services in the application and was used on or in connection with the goods/services in the application as of the application filing date; and To the best of the signatory's knowledge and belief, the facts recited in the application are accurate.
- ☐ To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.

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- 1 □ *To the best of the signatory's knowledge and belief, no other persons, except,*
2 *if applicable, concurrent users, have the right to use the mark in commerce,*
3 *either in the identical form or in such near resemblance as to be likely, when*
4 *used on or in connection with the goods/services of such other persons, to*
5 *cause confusion or mistake, or to deceive.*

6 70. In Counter-Defendant's application for registration, filed on November 3, 2020,
7 Mr. Stephen C. Beuerle, identified as "Attorney of record" for Counter-Defendant, signed the
8 declaration above. Counter-Defendant's application for registration of the US TURF standard
9 character word mark, including the signed declaration, is attached hereto as **Exhibit A**.

10 71. Based on the prominence of the aforementioned notices, Counter-Defendant knew
11 and was well aware of its obligation to refrain from knowingly making any false, material
12 statements to the US PTO in connection with its trademark registration application.

13 72. Mr. Beuerle is with the same law firm that sent the October 21, 2020, cease and
14 desist letter to Counterclaimant on behalf of Counter-Defendant demanding that Counterclaimant
15 cease using US TURF in connection with turf installation services, and so Mr. Beuerle and
16 Counter-Defendant had personal knowledge of Counterclaimant's active use of the US TURF
17 business name within the Las Vegas metropolitan area in connection with turf installation services.

18 73. Before and on the date Counter-Defendant filed the foregoing application for
19 registration of the standard character word mark US TURF, Counterclaimant was using the US
20 TURF trademark within the Las Vegas metropolitan area on or in connection with the advertising,
21 sale, and offering for sale of artificial turf installation services and Counter-Defendant had actual
22 knowledge of such use of the exact identical mark in connection with artificial turf installation
23 services.

24 74. Despite Counter-Defendant's actual knowledge of Counterclaimant's use of the
25 identical mark in connection with identical service and despite being aware of the consequences
26 of making false materials statements to the US PTO, Counter-Defendant, through its
27 representative, nevertheless signed the declaration section of the US TURF trademark registration
28 application attesting that to the best of his/Counter-Defendant's knowledge, no other persons have
the right to use the mark in commerce, either in the identical form thereof or in such near

1 resemblance thereto as to be likely, when used on or in connection with the goods/services of such
2 other persons, to cause confusion, or to cause mistake, or to deceive.

3 75. Counter-Defendant's express representations to the US PTO that it knew of no
4 other third parties that had the right to use the US TURF mark in connection with "laying of
5 artificial turf" were knowingly false or fraudulent because Counter-Defendant had actual
6 knowledge of Counterclaimant's existing prior use of the US TURF mark in connection with
7 "laying of artificial turf" as evidenced by Counter-Defendant's October 21, 2020 letter to
8 Counterclaimant.

9 76. Moreover, the false representation made by Counter-Defendant that "no other
10 persons have the right to use the mark in commerce, either in the identical form thereof or in such
11 near resemblance thereto as to be likely, when used on or in connection with the goods/services of
12 such other persons, to cause confusion, or to cause mistake, or to deceive," was made willfully to
13 the US PTO with a deliberate intent to deceive and mislead the US PTO into issuing a US
14 trademark registration for the US TURF standard character word mark.

15 77. By Counter-Defendant's submission of a false and fraudulent claim that it was not
16 aware of any third parties having the right to use the US TURF mark in connection with "laying
17 of artificial turf," Counter-Defendant knowingly made such false representations to the US PTO
18 with an intent to deceive and in order to induce to the US PTO to register the US TURF word mark
19 despite Counter-Defendant's full knowledge of Counterclaimant's existing prior usage rights to
20 the same mark in connection with the same services, and the US PTO relied upon such
21 representations in approving Counter-Defendant's US TURF word mark for publication.

22 78. Upon information and belief, but-for Counter-Defendant's knowingly fraudulent
23 representations, the US PTO would not have issued the US TURF registration to Counter-
24 Defendant.

25 79. Counter-Defendant thus obtained the US TURF federal trademark registration as a
26 result of a material and fraudulent representation to the US Patent and Trademark Office, making
27 the resulting trademark registration of the US TURF word mark obtained in violation of 15 U.S.C.
28 § 1120.

80. Counter-Defendant's false and/or fraudulent procurement of the US TURF word mark registration has damaged and will continue to damage Counterclaimant in violation of 15 U.S.C. § 1120 unless enjoined by this Court. Counterclaimant has no adequate remedy at law.

81. As a result of Counter-Defendant's procurement of the US TURF word mark registration outlined above, through a false or fraudulent representation to the US PTO, Counterclaimant has suffered damages for which Counter-Defendant is liable in an amount to be determined at trial.

SIXTH COUNTERCLAIM

(Cancellation of the US TURF Trademark Registration Obtained by Fraud)

82. Counterclaimant repeats, realleges and incorporates herein each of the foregoing allegations in the preceding paragraphs of these Counterclaims as if fully set forth herein.

83. This is a counterclaim for cancellation pursuant to 15 U.S.C. §§ 1120 and 1064(3)).

84. In reliance upon Counter-Defendant's materially false representations to the US PTO that it was not aware of any third parties having the right to use the US TURF mark in connection with "laying of artificial turf," the US PTO issued US Trademark Registration No. 6,439,091.

85. Because US Trademark Registration No. 6,439,091 for the standard character word mark US TURF was issued by the US PTO in reliance upon Counter-Defendant's false representation of a material fact that Counter-Defendant knew was false at the time, such registration is contrary to the provisions of 15 U.S.C. § 1120 and subject to cancellation under 15 U.S.C. §1064(3), and therefore, this Court, under 15 U.S.C. §1119, should order that US Trademark Registration No. 6,439,091 be canceled in order to rectify the register.

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PRAYER FOR RELIEF

WHEREFORE, in consideration of the foregoing, Counterclaimant respectfully requests that this Court enter an Order granting it the following relief:

A. Issue an order declaring that Counterclaimant's use of the US TURF name in the Las Vegas metropolitan area does not infringe upon any of Counter-Defendant's rights under the trademark laws of the United States;

B. Issue an order declaring that Counterclaimant has priority of use of the US TURF mark in the Las Vegas metropolitan area;

C. Issue an order declaring that Counterclaimant has the right to continue to use the US TURF mark in connection with the sale of turf installation services in the Las Vegas metropolitan area free from any interference by Counter-Defendant, its officers, agents, employees, attorneys, privies, representatives, successors and assigns, and any and all persons acting in active concert or participation with or under authority from Counter-Defendant;

D. Issue an order enjoining Counter-Defendant from using the US TURF mark in connection with providing any turf installation services within the Las Vegas metropolitan area;

E. Pursuant to 15 U.S.C. § 1119, issue an order to the Director of the United States Patent and Trademark Office (a) canceling US Trademark Registration No. 6,439,091; or alternatively (b) modifying US Trademark Registration No. 6,439,091 to be a concurrent registration covering the entire United States except the Las Vegas metropolitan area; or alternatively (c) modifying US Trademark Registration No. 6,439,091 so that it is amended to be on the Supplemental Register of the US PTO;

F. Entering a judgment that Counter-Defendant's US Trademark Registration No. 6,439,091 was procured by means of a false or fraudulent representation;

G. Pursuant to 15 U.S.C. § 1120, awarding any damages to Counterclaimant that it sustained and continues to sustain in consequence of Counter-Defendant's procurement of US Trademark Registration No. 6,439,091 by means of a false or fraudulent representation;

H. Awarding Counterclaimant its attorneys' fees pursuant to 15 U.S.C. § 1117 because of the exceptional nature of this case;

- 1 I. Awarding Counterclaimant its costs in connection with this litigation; and
2 J. Granting Counterclaimant such other and further relief as the Court may deem just
3 and proper.

4
5 **DEMAND FOR JURY TRIAL**

6 Under Rule 38 of the Federal Rules of Civil Procedure, Defendant/Counterclaimant
7 requests a trial by jury of all issues so triable.

8
9 Dated: November 2, 2021

10 Respectfully Submitted,

11 **GILE LAW GROUP, LTD.**

12 /s/ Ryan Gile

13 Ryan Gile, Esq.

14 Nevada Bar No. 8807

15 ***rg@gilelawgroup.com***

16 1180 N. Town Center Drive, Suite 100

17 Las Vegas, Nevada 89144

18 Tel. (702) 703-7288

19 *Attorney for*

20 *Defendant/Counterclaimant US TURF LLC*

CERTIFICATE OF SERVICE

I hereby certify that on November 2, 2021, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I further certify that a true and correct copy of the foregoing document is being served via transmission of Notices of Electronic Filing generated by CM/ECF to all participants in the case who are registered CM/ECF users.

/s/ Ryan Gile
Employee, Gile Law Group Ltd.